UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/823,008 | 04/13/2004 | Dana Eagles | 930007-2166.A | 4697 |

20999 7590 07/15/2005

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

| EXAMINER | |
|---|---|
| WRIGHT, ANDREW D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3617 | |

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/823,008 | EAGLES ET AL. | |
| | Examiner | Art Unit | |
| | Andrew Wright | 3617 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *29,32-36,44 and 47-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *29 and 36* is/are allowed.

6)☒ Claim(s) *33,35,44 and 47-55* is/are rejected.

7)☒ Claim(s) *32 and 34* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.



8.00

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 44 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawthorne et al. (US 2,997,973) in view of Shimozono et al. (US 6,021,915). Hawthorne discloses the elements of claim 44. Hawthorne discloses weaving. Hawthorne does not disclose warp and weft fibers or yarns. Shimozono shows a flexible fabric tubular structure for holding fluid. The tube is woven using warp and weft yarns. Such is well known and common. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawthorne by using warp and weft yarns in the weave of the tubular structure. The motivation would be to use weaving techniques that are well known in the art.

3. It is noted that the claim 44 recitation "wherein the tapered end is woven by gradually eliminating ... during weaving" is a product by process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP 2113. Hawthorne in view of Shimozono discloses the structure.

4. Claims 47-50, 54, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawthorne et al. (US 2,997,973) in view of Fowler et al. (US 4,055,201). Regarding claim 54, Hawthorne shows a vessel comprising a tubular structure (1) that is: elongate, flexible, made of fabric, impervious, and has front and rear sealed ends. The vessel comprises a pipe for filling and emptying cargo. The vessel is woven in one piece as a continuous tube. The front end (2) is tapered to a circumference that is less than the circumference of the central portion. The rear end (10) is also tapered to a circumference that is less than the circumference of the central portion. Hawthorne discloses weaving. Hawthorne dos not disclose knitting and braiding. Fowler shows a flexible tubular structure for holding fluids. The tubular structure is made of fabric and can be woven, braided, or knitted. Thus Fowler shows the equivalence of a woven, braided, or knitted fabric tubular vessel. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawthorne by making the tubular vessel a knitted tubular vessel or a braided tubular vessel. The motivation would be to make and use the vessel using fabrics that are well known in the art.

5. Regarding claims 47 and 48, Fowler discloses knitting or braiding. It would have been obvious to use knitting based upon Fowlers disclosure.

6. Further regarding claim 47, it is noted that the recitation "formed by gradually dropping ... of said tapered end to create the taper" is a product by process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only

the structure implied by the steps. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP 2113. Hawthorne in view of Fowler discloses the structure.

7. Regarding claims 49 and 50, Fowler discloses knitting or braiding. It would have been obvious to use knitting based upon Fowlers disclosure.

8. Further regarding claim 49, it is noted that the recitation "formed by adjusting the speed ... that is being braided" is a product by process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP 2113. Hawthorne in view of Fowler discloses the structure.

9. Regarding claim 55, Hawthorne shows that both the front and rear ends have tapers.

10. Claims 33, 35, 52, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawthorne et al. (US 2,997,973) in view of Fowler et al. (US 4,055,201). Hawthorne in view of Fowler, as described above with respect to claims 47-50, 54, and 55, discloses the knitted or braided structure with tapered ends. Hawthorne in view of Fowler does not explicitly disclose the recited method steps. The method steps, however, are inherent in the making and use of the modified Hawthorne

apparatus. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the recited method steps. The motivation would be to make and use the modified Hawthorne apparatus.

### *Allowable Subject Matter*

11. Claims 29 and 36 are allowed.

12. Claims 32 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Response to Arguments*

13. Applicant's arguments filed 4/29/05 with respect to the drawings are persuasive. The objection is withdrawn.

14. Applicant's arguments filed 4/29/05 with respect to claims 29-36 and 44-51 have been considered but are moot in view of the new ground(s) of rejection. However, the arguments will be addressed in order to advance prosecution since the new grounds of rejection are similar to those argued.

15. Applicant argues that Shimozono and Fowler are nonanalogous art. Applicant draws attention to MPEP §2141.01(a). Applicant correctly recognizes the two prong test. It is the examiner's position, however, that applicant mischaracterizes his invention for purposes of the argument. And this is why the argument is not persuasive.

16. It is noted that MPEP §2141.01(a) gives exemplary cases to demonstrate what is and what is not analogous art. The exemplary cases are divided into the chemical, mechanical, electrical, and design arts. Applicant's invention falls within the mechanical arts. The MPEP §2141.01(a) analysis regarding the mechanical arts discusses four cases. In all four discussions the focus is on applicant's claims. Thus it is asserted that the claimed invention is what defines the field of endeavor or problem with which the inventor was concerned.

17. In attempting to distinguish his invention from Shimozono and Fowler, applicant characterizes his invention as "large", "very large", with "a length of 300 feet or more and a diameter of 40 feet or more" and uses phrases including "for the ocean transportation", "with ocean transportation", and "towed through the ocean". Applicant does not recite towing, or ocean going, or any specific length or diameter. As such it is the examiner's position that the invention, as claimed, pertains to a fabric container for holding and transporting fluid. Thus the field of endeavor is making a fabric container for holding and transporting fluid. And the particular problem with which the inventor is concerned is how to construct the fabric container with tapered ends. (Applicant does use the word "large" in the preamble of each independent claim. The term "large" however is relative. A centimeter is large compared to a micrometer. Thus anything that is bigger than something else is large.)

18. Shimozono discloses a "water tank which has a cylindrical shape and which is composed of a specified woven cloth" (see Shimozono, column 1, lines 25-30). Shimozono claims "[a] foldable water tank ... made from ... a woven cloth sheet" (see

Shimozono, claim 2). That is a fabric container for holding fluid. Fowler discloses "nonaerosol fluid dispensing containers and more particularly to an expansible fabric for providing the force which dispenses the fluid from the container" (see Fowler, column 1, lines 13-16). Fowler claims "[a]n expansible fabric suitable for disposition about a fluid containing expansible member" (see Fowler, claim 1). That is a fabric container that holds a liquid within its enclosed volume. Both Shimozono and Fowler disclose details of how the fabric containers are constructed. Thus both Shimozono and Fowler are within applicant's field of endeavor or alternatively address the same problem as applicant. Therefore Shimozono and Fowler are analogous art and applicant's argument is not persuasive.

19. Alternatively, if applicant's field of endeavor and problem to be solved are determined from applicant's disclosure, then applicant's argument still fails. It is asserted that applicant's invention is essentially a very large fabric container for holding and transporting water, and that the problem to be solved is how to construct the fabric container. Applicant is correct that Shimozono and Fowler disclose much smaller articles. But scale is generally easily modified by the skilled artisan. It is asserted that Shimozono and Fowler disclose essentially the same structure, a fabric container for holding water, on a much smaller scale. Thus they are in the same field of endeavor. Furthermore, it is asserted that Shimozono and Fowler address the same problem despite their smaller size: how to construct a fabric container for holding water.

Therefore Shimozono and Fowler are analogous art and applicant's argument is not persuasive.

***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number 571-272-6690. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at 571-272-6684. The fax number for

official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 571-273-6690.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright
Patent Examiner
Art Unit 3617